

REMARKS

Drawing Objections

Applicant amends paragraph [0045] of the application to include reference to Step 108 in Fig. 2. This change fully addresses the noted drawing objections.

Objection to Claim 24

Claim 24 is canceled. Claim 25 is correspondingly amended to depend on claim 22 rather than claim 24 and to conform its language to the changed dependency.

35 U.S.C. § 112 Claim Rejections

The rejection of claims 1-14 and claims 26-30 as being indefinite under 35 U.S.C. § 112, second paragraph, is improper. At issue is Applicant's use of the term "default" within these rejected claims, and the basis for the indefiniteness rejections is the assertion that Webster's Collegiate Dictionary defines "default" as "in the absence of". One need do no more than turn to the Merriam-Webster dictionary to see that the definition cited by the examiner applies not to the word "default," but rather to the phrase "in default of".

Indeed, in the Merriam-Webster Dictionary, see, e.g., www.m-w.com, the definition of the word "default" includes "a selection made usually automatically or without active consideration due to lack of a viable alternative," or "a selection automatically used by a computer program in the absence of a choice made by the user." Applicant's use of the word "default" in the rejected claims plainly is not inconsistent with the dictionary definition, and the entire basis of the examiner's indefiniteness rejections are based on wrongly referring to the definition of the phrase "in default of," rather than the definition for the word "default."

Section 2173 of the MPEP sets for the test for claim indefiniteness under 35 U.S.C. § 112, second paragraph, as whether "those skilled in the art would understand what is claimed when the claim is read in light of the specification." (Citing to *Orthokinetics, Inc. v. Safety Travel*

Chairs, Inc., 806 F.2d 1565, 1576, 1 USPQ2d 1081, 1088 (Fed. Cir. 1986)). Applicant submits that its use of the term "default" in the rejected claims is abundantly clear to those skilled in the art, in view of the specification.

Because such usage is clear and not indefinite, and because the evidence offered by the Patent Office in support of the indefiniteness rejections is based on a plainly erroneous use of the Webster's Dictionary, Applicant respectfully requests that all indefiniteness rejections be withdrawn.

The Failure to Examine Claims 14 and 26-30

The Office Action notes its decision not to examine claims 14 and 26-30. This decision is improper and by itself prevents the next action from being made final. Particularly, the basis for this decision directly rests on the erroneous dictionary definition assigned by the Patent Office to the word "default" as used in the claims at issue. Claims 14 and 26-30 are readily examinable if only the Patent Office gives "default" its unambiguous meaning as consistent with the specification and its normally understood meaning. For example, paragraph [0048] of the instant application teaches that "default" transcoding formats may be those known to be generally used for Internet delivery of multimedia content. Non-limiting examples include Windows Media Audio (WMA), Advance Audio Coding (AAC), etc. Further, paragraph [0049] indicates that content may be transcoded into more than one default format, to increase the likelihood of providing compatibility with decoding at the targeted destination.

However, paragraph [0050] teaches that a database or other listing may indicate that specific transcoding formats apply to particular destination network addresses. In such instances, transcoding may use the specific format rather than a default format. As a non-limiting example that would be immediately appreciated from these teachings by one skilled in the art, transcoding might use WMA as a default transcoding format for email multimedia unless

a database indicated that a different, specific format was to be used for a particular destination network address.

Applicant submits that claims 14 and 26-30 were improperly excluded from examination on the merits.

35 U.S.C. § 102 Claim Rejections

Claims 1-4, 9-13, 15, 16, 18-20, 22-25, and 31-33 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. 2004/0111476 ("Trossen"). Critically, all such rejections fail and must be withdrawn, as the record established by the Patent Office explicitly demonstrates that the examiner used an improper definition of the term "default" as used in the rejected claims. In particular, at lines 22-23 on p. 3 of the Office Action, the examiner states that "[f]or purposes of prior art rejections, Examiner will treat the 'default format' to be any format specified by a destination address."

That definition is self-evidently illogical; moreover, that definition contradicts the plain meaning of the term "default format" as evident from its contextual use in the claims, and as evident from the clear and comprehensive examples and explanations appearing in the specification. See, e.g., paragraph [0009] in the Summary of the instant application, where the term "default format" is exemplified as a format known to be widely used for multimedia delivery. See, also, paragraph [0010], which teaches translating multimedia content into one or more such default formats for email delivery. Further, compare the juxtaposition of default and specific formats as given in the example of paragraphs [0048]-[0050].

The Patent Office's failure to properly construe the term "default format" is legal error and prevents proper examination of the claims at issue. For example, by saying that "default format" is any format specified by a destination address, the examiner states that Trossen's use

of "recipient rules" for message transcoding anticipates the rejected claims. That assertion is contradicted by Trossen's teachings and by the properly construed claims.

For example, claim 1 is directed to a "method of processing multimedia messages outgoing from an originating network," based on "selectively transcoding multimedia content in outgoing multimedia messages from a current format into a default format as a function of their destination network addresses," and "sending the messages according to their destination network addresses." (Emphasis added.) Applicant claims additional aspects of such processing, such as in claim 14, which depends from claim 1 and stipulates using a specified format rather than the default format, if a domain database indicates a specific format.

Trossen includes little or no detail regarding its manner of transcoding, other than the above recipient rules for transcoding. Trossen manifestly does not disclose selectively transcoding into a default format, nor does Trossen allude to any desirability for using default formats for transcoding. In contrast, the instant application teaches that significant advantages are gained by selectively transcoding multimedia into one or more default formats, where the instant application explains that such default formats are known to be generally used for given multi-media types, etc. Tellingly, Applicant explains (and claims) that specified transcoding rather than default transcoding may be used where a specific transcoding format is indicated for a particular destination address.

A reference anticipates a claim only if it teaches each and every limitation of the claim, in the identical arrangement as claimed. Trossen does not discuss selectively transcoding into a default format, and therefore cannot as a matter of law be said to anticipate claim 1. As the same or similar limitations appear in the other independent claims (15, 22, and 32) rejected as anticipated by Trossen, these remaining independent claims are not anticipated by Trossen. Still further, independent claim 26, improperly omitted from examination by the Patent Office, self-evidently is not anticipated by Trossen.

With regard to the above evidence and arguments, Applicant submits that claims 1-4, 9-13, 15, 16, 18-20, 22, 23, 25, and 31-33 are not anticipated by Trossen. (Note that claim 24 was similarly rejected but is now canceled.)

35 U.S.C. § 103 Claim Rejections

Claims 5-8, 17, and 21 are rejected under 35 U.S.C. § 103(a) as being obvious over Trossen. These rejections are not supported by the teachings of Trossen, and are in any case made moot by the patentability of the independent claims over Trossen.

Closing

Applicant amends the specification herein to address the drawing objection, and cancels claim 24 to address the objection to it. All remaining claim rejections and objections are improper as depending directly on the legally erroneous construction given to the term "default format" in the claims at issue. As the above evidence and arguments demonstrate, the claims at issue patentably define over Trossen when the claims are properly construed, and Applicant correspondingly requests the withdrawal of all such objections and rejections.

Respectfully submitted,

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Dated: January 29, 2008